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The Possibilities of Discovery in Patent Litigation: Some Recent Judicial Developments*

WITH the advent of the new equity rules, supplemented perhaps by an awakened legal conscience,¹ fresh reasons are presented why we should inquire into the manner and means by which time, expense and annoyance to the courts, the Bar and the public may be saved or avoided in making proofs, and otherwise maturing cases for trial on their merits.

We must all be appreciative and in more or less degree deserving of the varied criticisms directed impartially at Bench and Bar for the delays and expense incident to litigation, and especially patent litigation. One of the chief deterrents to the bringing of rightful actions, and conversely, the chief reliance of wilful infringers, is the practical knowledge that a patent law suit is too often a rich man's prerogative. Yet, if the Bar as a unit would but realize that patent suits, as we have been told by a distinguished gentleman at a former meeting of this Association,² have increased in England in direct proportion to the lessening of time and expense in trying cases, there might be an automatic ending of much that has given rise to criticism on the part of the public in this country.

Critics and reformers have sought, as a rule, for improvement in legislation, whereas the possibilities and potentialities of the laws now in force are largely sufficient for the alleviation of such onerous conditions as may present themselves in practice.

As you all know, discovery has long been an invaluable aid in the administration of equitable remedies, its function being often

*Address delivered before the Patent Section at the annual meeting of the American Bar Association, at Salt Lake City, August, 1915.

¹ Supposedly we may speak of an awakened legal conscience, as well as of an awakened civic, or public, or national conscience. A "legal" conscience portends a recognition, at least, of a dormant fact rather than the invention of a new fiction.

² A. J. Walters, K. C. (1913), 38 Am. Bar Assn. Rep. 789.

available in aid of actions at law; hence the new equity rules have not so much introduced innovations, as they have offered a new starting-point in regard to things that have long been recognized as desirable, but the doing of which had grown more and more difficult as they became shrouded in precedent, linked to the past.

Whatever tends to draw forth information from one party to an action, in aid of the other party's cause of action or defense, prior to trial, may be considered as in the nature of a "discovery," irrespective of the name or the particular means by which the end is attained: Whether it be (1) by the old bill of discovery in aid of an action at law;³ or (2) by interrogatories in a bill or cross bill, under the old chancery practice; or (3) in a law action, by motion to make a complaint more definite and certain, so as to particularize the infringement;⁴ or (4) by a bill of particulars to ascertain the measure of damages which a plaintiff will rely on in an action at law; or (5) by motion to make a bill or answer, or both, more definite and certain under new equity rules 25 and 30, so as to require a plaintiff or defendant, or both, to set forth, respectively, the essential novelty of the patent sued on, or essential aptness of the prior art set out in an answer under section 4920;⁵ or (6) by a proceeding for discovery under new equity rule 58;⁶ or (7) where one party is left in doubt as to the position of the other concerning the latter's theory of the case, by a motion of such party to have the depositions of the experts of *both* parties taken under new equity rule 48, assuming the validity of such a course, regarding which some doubt is entertained by text writers and by the Bar.

With the exception of proceedings under new equity rule 48, these are all more or less in the nature of demands for additional evidence addressed to the conscience of one or the other of the parties, and the courts have frequently said that litigants ought to have their consciences searched, for by so doing time is saved, expense is avoided, and the court is able the more readily to reach and deal with the very thing in dispute.

It is obviously desirable to ascertain the merits of a case at its outset, so far as may be practicable when this can be done with the

³ *Colgate v. Compagnie Francaise du Telegraphe de Paris etc.* (1885), 23 Fed. 82.

⁴ *Fischer v. Auto. Supply Mfg. Co.* (1912), 199 Fed. 191.

⁵ *Coulston v. Franke Steel Range Co.* (Mar. 8, 1915), 221 Fed. 669.

⁶ *Bronk v. Chas. H. Scott Co.* (1914), 211 Fed. 338; *P. M. Co. v. Ajax Rail Anchor Co.* (1914), 216 Fed. 534; *Luten v. Camp* (Mar. 17, 1915), 221 Fed. 424; *Blast Furnace Appliances Co. v. Worth Bros. Co.* (Mar. 17, 1915), 221 Fed. 430.

formalities and safeguards of regular procedure, rather than to await the result of an elaborate trial—the public, as well as the immediate litigants sharing in this gain. These considerations are not limited to equity suits, but are shared by actions at law.

Therefore, in considering the subject of “discovery” it seems proper to treat it in this broader aspect, rather than to limit it to interrogatories.

BILLS OF DISCOVERY.

The want of power in the common law courts to compel a disclosure of the truth, either through the oath of the party to the suit, or by process of its own to compel the production of written evidence in the possession of an adverse party, brought forth that invention of equity, known as the bill of discovery, whereby the right to demand information known only to the defendant, in aid of the plaintiff’s suit, was permitted. By a bill of discovery, a plaintiff could interrogate a defendant, but the defendant could not interrogate a plaintiff, except on the filing of a cross bill.

Bills of discovery, in patent litigation at least, are rendered practically obsolete, since there is no apparent excuse for their invocation in aid of an action at law on a patent. If the plaintiff wants discovery, let him go into equity for it in the first place.⁷

⁷ Since bills of discovery, as historical precedents, are to play an important part, no doubt, in the future interpretation of the new rules, attention is called to the modern and leading case on this subject, *Colgate v. Compagnie Francaise du Telegraphe de Paris, etc.* (1885), 23 Fed. 82, where Judge Wallace clearly sets out the functions and limitations of such bills.

There defendant was a cable company operating a cable telegraph between France and the United States. The alleged infringing cable, including the mode and materials of its construction were in the complete control of the defendant and while the plaintiff in the action at law had a reasonable suspicion evidently of infringement, yet when the answer came in denying infringement, the plaintiff became unable to prosecute its action without a full discovery of the method of insulation of these lines of cable telegraph, for the reason that the lines were under water and not open to plaintiff’s inspection. Thereupon the plaintiff filed a bill of discovery in aid of its action at law. The defendant filed a demurrer to the bill, claiming, first, that the defendant, as a corporation, could not be compelled to make a discovery; and, second, that the discovery should be refused in view of section 724 of the Revised Statutes.

The first ground of demurrer was overruled on the ground that, while a corporation cannot be compelled to answer under oath to a bill in equity, (and for that reason it was usually customary for the officers of the corporation to be made parties to the bill, and to require them to answer the interrogatories), yet that did not excuse the corporation from answering and making diligent examination so as to

DISCOVERY IN LAW ACTIONS.

In focusing attention on the new equity rules and awaiting the court's interpretation of them, supported and assisted by the Bar, we are not to lose sight of the fact that patent causes are still triable as law actions. As in the future cases are still liable and certain to be tried as actions at law, there are two recent decisions, bearing on the subject of discovery, that command the attention of the patent Bar, and of the courts having jury cases involving patent matters coming before them. I refer to the cases of *Carpenter v. Winn*,⁸ treating of the proposition of discovery of documents under section 724 of the Revised Statutes; and *Fischer v. Automobile Supply Manufacturing Company*,⁹ relating to discovery of facts by a defendant on the question of infringement.

Until the decision of the Supreme Court in *Carpenter v. Winn*, construing section 724 of the Revised Statutes, parties in patent actions had frequently invoked it in aid of discovering documents and other papers, in preparation for trial. Section 724 is substantially the fifteenth section of the Judiciary Act of 1789, and is as follows:

"In the trial of actions at law, the courts of the United States may, on motion and due notice thereof, require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceeding in chancery. If a plaintiff fails to comply with such order, the court may, on motion, give the like judgment for the defendant as in cases of nonsuit; and if a defendant fails to comply with such order, the court may, on motion, give judgment against him by default."

The purpose of this provision is to provide a substitute for the bill of discovery in aid of a legal action. As Justice Lurton pointed out, the penalty for failing to comply with such an order as the statute provided is exceedingly stringent,—that of a nonsuit or a judgment by default.¹⁰

give in the answer all the information derived from such examination. An allegation of ignorance without excuse would infer a disposition to defeat and obstruct the course of justice. The second ground of demurrer was overruled by reason that section 724 of the Revised Statutes did not apply.

Measured by our present method of procedure in equity, the cumbersomeness of such a double litigation is manifest.

⁸ (1911), 221 U. S. 533, 55 L. Ed. 842.

⁹ (1912), 199 Fed. 191.

¹⁰ In this particular, it is interesting to compare the Act with the provision of new equity rule 58, par. 5.

Justice Lurton in the Carpenter case pointed out that for more than a century trial courts had disagreed as to whether, under the enactment of section 724, the procedure was limited to a requirement that the books, documents and writings be produced at the trial, or in the discretion of the court, before the trial, for such investigation and examination as the party obtaining the order might desire. The learned Justice reviewed the authorities pro and con, and decided that the words "in the trial" meant *at the trial*, and not before the trial, or in preparation for trial; one reason for giving a strict construction being that the statute imposed severe penalties on a party's refusing to comply with the demand to produce: i. e. (1) If the papers called for are not produced on the motion, he may be unable to argue against the other party on producing them to the jury; (2) The party failing to produce may be defeated in his object to obtain evidence from the contents of the papers called for; and (3) A nonsuit or judgment by default may be entered against him. Another reason for so holding was that the materiality of the papers cannot be determined except during the trial because it would occupy time unnecessarily, and it might be very difficult to decide beforehand whether a paper was pertinent to the issue, and whether it was so connected with the case that a court of equity would compel its production.

Justice Lurton drew a clear distinction between proceedings under the statute, and proceedings to obtain a disclosure under the ordinary chancery practice, indicating that, in the latter case, the evidence must in the very nature of things result in production before the trial.

In holding that section 724 did not take away the right of a party in a law action to a bill of discovery, nor give a broader right than afforded by a discovery proceeding in equity, Justice Lurton remarked:

"Another consideration leading to the same conclusion is found in the fact that a bill of discovery cannot be used merely for the purpose of enabling the plaintiff in such a bill to pry into the case of his adversary to learn its strength or weakness. A discovery sought upon suspicion, surmise or vague guesses is called a 'fishing bill,' and will be dismissed. Story, Eq. Pl., §§ 320 to 325. Such a bill must seek only evidence which is material to the support of the complainant's own case, and prying into the nature of his adversary's case will not be tolerated."

Many of the answers to questions which will arise under new

equity rule 58, as to discoveries and interrogatories, find their answer in Justice Lurton's very interesting opinion.

MOTION TO MAKE A COMPLAINT MORE CERTAIN.

A thoroughly practical method of discovery in patent law actions is that indicated by Judge Chatfield in *Fischer v. Automobile Supply Manufacturing Company*.¹¹ This was a suit, brought on a patent issued in 1910, seeking the recovery of damages. Defendant brought a motion, alleging that the only articles used or sold by it were made under prior patents owned by it, one issued in 1890 and expired, and the other issued in 1905, and moved that the complaint be made more definite and certain. This motion was granted, the court holding that the defendant was entitled to know that with which it was charged, so as to determine whether the information upon which its answer was to be drawn was within its own possession.

After expressly stating that neither the New York code sections concerning matters of evidence, nor section 914 of the Revised Statutes, whereby procedure in the federal courts is to conform as nearly as may be to the practice in the state courts, had any bearing on the proceedings undertaken by the defendant, the court held, nevertheless, that, on sound principles of good pleading, the plaintiff should be required to particularize sufficiently so that an issue could be raised, and the allegations of fact of the complaint could be definitely made out for the purpose of framing the issue. Judge Chatfield said:

"If the plaintiff herein intends to charge that the general trade output of the defendant (viz. of articles made under the patents referred to), infringes the patent subsequently obtained by the plaintiff, or that the defendant has no right to use those patents, then he should state the acts which are alleged to be infringements, with sufficient definiteness so that the defendant may raise this issue.

"On the other hand, if he claims that the defendant has infringed by the sale of articles differing from the patents claimed, or so changed that the defendant is not protected by those patents, and is infringing the plaintiff's patent thereby, then failure on the part of the defendant to realize or to avoid the consequences of what it has been doing, or a desire to learn the extent of knowledge on the part of the plaintiff, is

¹¹ (1912), 199 Fed. 191.

not sufficient reason to relieve the defendant from liability of preparing to meet the charge when presented on the trial.

"In other words, the court will not compel the plaintiff to disclose its evidence, but the motion will be granted to the extent of directing the plaintiff to make his complaint more definite and certain, as to whether the infringement is charged by the sale of articles admittedly corresponding or equivalent to the devices in the Almond and Scognamillo patents (the defendant's patents), or whether the devices sold by the defendant are claimed to differ from those patents, and to infringe that sued upon by the plaintiff."

The plaintiff then amended his complaint and charged that the infringement was by devices other than the two prior patents of defendant. The plaintiff thereupon found himself in the awkward situation of pleading in his complaint, not only his own patent, but the two prior patents relied on by defendant, whereupon defendant entered a demurrer, on the ground that the patent sued on was void on the prior art set up in the complaint. The demurrer was sustained and, in view of the Almond patent, the patent held void for lack of invention.¹²

This case offers a precedent that may well be followed in other cases where a plaintiff seeks, by a discreditable line of conduct, to harass or embarrass a competitor by bringing suits which are no more nor less than disguised blackmail proceedings.¹³

Such suits where wilfully brought, accompanied by threats against the trade dealing with or seeking to deal with defendants,

¹² *Fischer v. Auto. Supply Mfg. Co.* (1912), 201 Fed. 543, affirmed on appeal, (1913), 209 Fed. 225.

¹³ A third mode of discovery available undoubtedly to a defendant in a patent law action in special cases is by a bill of particulars.

To quote Vice-Chancellor Bacon in *Saunders v. Jones* (1877), 7 Ch. Div. 435:

"The notorious practice that the defendant has a right to require particulars on demand, is only an instance of the principle of discovery as it exists in common law, it being in its essence the same principle as that which has prevailed in the Court of Equity."

A bill of particulars might seemingly be proper in a patent suit at law to compel a plaintiff specifically to set out in his complaint the particular measure of damages which he intends to rely on.

"The damages incurred by the plaintiff on account of a defendant's infringement must be stated specially, because no particular damage necessarily arises from infringements of patents, and therefore none is implied by the law. The special damages to be alleged in any particular case depend upon the circumstances of that case; depend upon the particular criterion of damages upon which the plaintiff relies a special statement is required by the substantial principles of pleading as well as by its technical rules. Without it, the defendant would not be apprised of all the issues of the case. He would not know, till the day of trial, whether the plaintiff would prove an established royalty,

too often have and are intended to have the effect of paralyzing what is in fact the legitimate business of a defendant. The plaintiff knows that the mere assertion of the claim of right on his part is equivalent, in its effect upon the trade, to an adjudicated monopoly. As a consequence, the public refuses to incur any risk by dealing with the defendant, or to become involved in litigation, unless indemnified in such an amount as to render the business of the defendant unprofitable. The plaintiff thus practically secures all the benefits of a decree in his favor. The result is that the defendant's property is seriously impaired or even destroyed, particularly if the suit is allowed to continue for considerable length of time following the actual filing of the complaint or bill. The benefits of such a course as the defendants in the Fischer case were able to pursue, is especially apparent where the defendant is making several styles or lines of the same article each under a separate patent, or even unpatented, and where the infringement may involve, at best, only one of the more unimportant articles. Where a suit of that sort is brought, and the plaintiff advertises the fact, the injury to the defendant extends to his complete line, although his principal seller may not be within the patent sued on at all.

It may be that Judge Chatfield's action will not be generally followed by other courts in like circumstances. For example, Judge Van Fleet in a recent case in the Ninth Circuit¹⁴ declined to follow the Fischer case, although the facts were alike in both cases. Unquestionably where a defendant has a perfectly good excuse to the charge of infringement he should, if possible, be accorded an equal opportunity for a speedy dismissal of the action at law, as he is accorded in equity under the new rules.¹⁵

or would prove loss or reduction of his sales, or would prove reduction of his prices, as the criterion of his damages. The defendant would therefore have to go to court provided with witnesses on all these points, or would have to trust his sagacity, and guess which of these points he would be called upon to meet. It was to prevent such inconveniences that written pleadings were originally designed; and for the same purpose, among others, they are still retained in actions in court." Walker, Patents, § 436.

"In the absence of a demand for special damages, I do not think that the plaintiff should be required to particularize his claim for actual and punitive damages." *Patterson v. Corn Exchange of Buffalo et al.* (1912), 197 Fed. 686.

The last paragraph above is particularly pertinent to pleading in law actions for damages for infringement.

¹⁴ *Pacific Wall Bed Mfg. Co. v. Marshall & Stearns Co.*, at law, No. 15,512, unreported.

¹⁵ From the foregoing cases, we deduce that proceedings by way of discovery in actions at law in patent matters are still available in the following manners:

NEW EQUITY PROCEDURE.

Discovery is but one of the many phases of the new equity rules to speed the final hearing; as, for example, by rules 54, 55 and 56, cases at issue are automatically set on the calendar, and by rule 57, cases are automatically dismissed if allowed to lie dormant beyond

(1.) By bill of discovery in aid of an action at law for the production of books and writings, bills of discovery being available alike to plaintiffs and defendants. *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842; *Guyot v. Hilton* (1887), 32 Fed. 743; *Wilson v. New England Nav. Co.* (1912), 197 Fed. 88.

(2.) By a bill of discovery in aid of an action at law for the propounding of interrogatories.

(3.) By a bill of discovery in aid of an action at law for an inspection of an alleged infringing machine maintained in secrecy by the defendant. *Colgate v. Compagnie Francaise du Telegraphe, etc.* (1885), 23 Fed. 84.

(4.) By a bill of particulars.

(5.) By a subpoena duces tecum in aid of an action at law to produce documents and writings, including pending applications in and correspondence with the Patent Office. *Edison Electric Light Co. v. United States El. Lighting Co.* (1890), 44 Fed. 294.

(6.) By motion of a defendant to make the declaration more definite and certain, so as to inform a defendant whether the information upon which its answer is to be drawn is within its own possession. *Fischer v. Auto. Supply Mfg. Co.* (1912), 199 Fed. 191.

The following are some of the negative rules to be observed in attempt of discovery in an action at law:

(1.) In an action at law the production before trial of books and papers cannot be ordered upon motion. The party must seek relief through a bill of discovery. *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842.

(2.) State laws in aid of examination of a party before trial are not available in the federal courts. All testimony unless taken *de bene esse* or by commission must be taken in the presence of the court and jury at the trial. *Colgate v. Compagnie Francaise du Telegraphe, etc.* (1885), 23 Fed. 84; *Hanks Dental Co. v. International Tooth Crown Co.* (1904), 194 U. S. 303, 48 L. Ed. 989.

(3.) Likewise state laws enabling the production of books and papers in aid of examination, are not available before trial. *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842; *Wilson v. New England Nav. Co.* (1912), 197 Fed. 88, and cases cited.

(4.) Section 724 U. S. Rev. Stat. does not cover the examination of books and papers before trial; but permits such examination to be made only in the trial. *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842.

(5.) Neither can a defendant have an examination of the device which the plaintiff may rely upon as constituting the infringement by virtue of any state laws permitting inspection for the purpose of preparation of trial. That would be in the nature of an attempt to learn what the plaintiff's evidence of infringement against it may be. *Fischer v. Auto. Supply Mfg. Co.* (1912), 199 Fed. 191; *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842; *Wilson v. New England Nav. Co.* (1912), 197 Fed. 88; *Cheatham El. Switching Device Co. v. Transit Development Co.* (1911), 190 Fed. 202.

The new equity rules as promulgated by the Supreme Court of the United States have only been in effect since February 1, 1913.

the year. Additional automatic attachments to the rules of a similar character, would render them more desirable.

The reported cases dealing with discovery under the new rules are but few,¹⁶ yet they indicate a studious and earnest attempt to observe their intent in a considerable degree. Judge Orr, however, in the Western District of Pennsylvania, in the recent case of *Pittsburg Water Heater Company v. Beler Water Heater Company*,¹⁷ said in reference to practice under rules 25 and 30: "It has become apparent that solicitors in equity and especially solicitors in patent causes have hesitated to conform to the provisions of those rules."

What we may assume to be the spirit of the new rules is well expressed by Judge Baker, of the Circuit Court of Appeals for the Seventh Circuit, in *Bronk v. Charles H. Scott Company*,¹⁸ namely, "to enable the court to make a summary disposition of a cause by applying the law to an admitted state of facts."

This case seems to be the first one reported dealing directly with discovery by interrogatories under new equity rule 58,¹⁹ and

¹⁶ The cases so far reported, coming to the writer's attention are the following: *Bronk v. Scott Co.* (1914), 211 Fed. 338; *P. M. Co. v. Ajax Rail Anchor Co.* (1914), 216 Fed. 634; *Todd v. Whitaker* (1914), 217 Fed. 319; *Luten v. Camp* (Mar. 17, 1915), 221 Fed. 424; *Blast Furnace Appliances Co. v. Worth Bros. Co.* (Mar. 17, 1915), 221 Fed. 430; *Coulston v. H. Franke Steel Range Co.* (Mar. 8, 1915), 221 Fed. 669; *Pittsburg Water Heater Co. v. Beler Water Heater Co.* (Apr. 15, 1915), 222 Fed. 950.

¹⁷ (Apr. 15, 1915), 222 Fed. 950.

¹⁸ (1914), 211 Fed. 338.

¹⁹ Equity rule 58 is as follows: "Discovery—Interrogatories—Inspection and Production of Documents—Admission of Execution or Genuineness.

"The plaintiff at any time after filing the bill and not later than 21 days after the joinder of issue, and the defendant at any time after filing his answer and not later than 21 days after the joinder of issue, and either party at any time thereafter by leave of the court or judge, may file interrogatories in writing for the discovery by the opposite party or parties of facts and documents material to the support or defense of the cause, with a note at the foot thereof stating which of the interrogatories each of the parties is required to answer. But no party shall file more than one set of interrogatories to the same party without leave of the court or judge.

"If any party to the cause is a public or private corporation, any opposite party may apply to the court or judge for an order allowing him to file interrogatories to be answered by any officer of the corporation, and an order may be made accordingly for the examination of such officer as may appear to be proper upon such interrogatories as the court or judge shall think fit.

"Copies shall be filed for the use of the interrogated party and shall be sent by the clerk to the respective solicitors of record, or to the last known address of the opposite party if there be no record solicitor.

the action taken there was so revolutionary as to constitute a monument in patent practice. Although Judge Baker treated but meagerly the question of interrogatories, the case involved a clever tactical move on the part of the defendant in combining an unusual answer with a subsequent set of interrogatories based on the answers.

The patent concerned a simple garment or apron, with one claim, and the bill charged infringement in the usual mode.²⁰ The answer set out that the patentee had sought, during the pendency of the application in the Patent Office, to overcome the prior art by limiting the claim of the patent to the exact details described and shown; that no invention was required to devise the patented article; that the only devices the defendant had ever made or sold were represented by actual specimens which were filed with and made a part of the answer; and that there was no infringement.

"Interrogatories shall be answered and the answers filed in the clerk's office within 15 days after they have been served, unless the time be enlarged by the court or judge. Each interrogatory shall be answered separately and fully and the answers shall be in writing, under oath, and signed by the party or corporate officer interrogated. Within 10 days after the service of interrogatories, objections to them, or any of them, may be presented to the court or judge, with proof of notice of the purpose so to do, and answers shall be deferred until the objections are determined, which shall be at as early a time as is practicable. In so far as the objections are sustained, answers shall not be required.

"The court or judge, upon motion and reasonable notice, may make all such orders as may be appropriate to enforce answers to interrogatories or to effect the inspection or production of documents in the possession of either party and containing evidence material to the cause of action or defense of his adversary. Any party failing or refusing to comply with such an order shall be liable to attachment, and shall also be liable, if a plaintiff, to have his bill dismissed, and, if a defendant, to have his answer stricken out and be placed in the same situation as if he had failed to answer.

"By a demand served 10 days before the trial, either party may call on the other to admit in writing the execution or genuineness of any document, letter, or other writing, saving all just exceptions; and if such admission be not made within five days after such service, the costs of proving the document, letter, or writing shall be paid by the party refusing or neglecting to make such admission, unless at the trial the court shall find that the refusal or neglect was reasonable."

²⁰ The claim was as follows: "A protector, comprising a permeable yoke portion provided with a median seam and having its upper portion contracted and folded into downwardly and laterally-extending tapering plaits or folds on each side of said median line, and an impermeable portion comprising a single ply of material depending from said yoke portion, said yoke portion being provided about its upper edges with a waistband and said shield portion being provided with attaching-tabs near the depending end thereof."

The portion of the claim stated in the first four lines quoted above was absent from defendant's structures.

Thereupon, the defendant under equity rule 58 filed interrogatories to be answered by the patentee, plaintiff, inquiring whether the charge of infringement was based on any of the exhibited specimens of defendant, or on some other or different articles. The patentee answered the interrogatories by saying that she had no other basis for her charge of infringement.²¹ The defendant then moved to dismiss the bill, on the ground that the plaintiff's answer to the interrogatories disclosed that there was no infringement and on the further ground that, in view of the file wrapper and prior patents, certified copies of which were filed with the motion, the patent was void for lack of invention.

On appeal from a decree granting the motion and dismissing the bill, Judge Baker pointed out that the file wrapper and patents could not be considered on the motion, because the motion must be considered like a demurrer, and only those things appearing on the face of the bill, and things properly before the court in the answer, or facts admitted by the appellant, plaintiff below, could be regarded. The validity of the patent was conceded, and the only question was its construction with respect to infringement. The court said:

"Applying this rule to the admitted facts, we have no difficulty in sustaining the decree. The description of the yoke portion of appellant's patented article shows tapering plaits which have the effect of giving the surface of the yoke a spheroidal form. And the claims make this an indispensable characteristic of the yoke portion. So it is immaterial what, if any, disclaimers appellant was compelled to make during the prosecution of her application through the Patent Office, or what were the teachings and disclosures of the prior art. If it were admitted that appellant was the absolute pioneer in protectors of this character, and was in fact the first inventor of plane as well as spheroidal shapes, still it is the province of courts only to construe claims, not to reconstruct them. And it

²¹ English rules 13 and 14 of Order LIIIa provide:

"13. In an action for infringement of a patent the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.

"14. Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed and shall give at least one instance of each type of infringement of which complaint is made."

A greater degree of precision is required in the particulars of breaches where the defendant is the vendor than where he is a manufacturer, and in one case plaintiff was required to specify certain infringing garments known to the trade as "The Champion" and "The Distingue." *Mandleberg v. Morley* (1893), 10 R. P. C. 260.

would require an entire reconstruction of the claim to eliminate what appellant has made an essential element, namely, the spheroidal form of the yoke portion; and inasmuch as appellant admits that appellee has never made or sold protectors except those in which all of the parts have plane surfaces, no testimony with respect to the utility, novelty and commercial success of appellant's article, and no exposition of the prior art by experts, could alter the result, which is non-infringement."²²

The rule there invoked and followed is a salutary one, and it is designed to accomplish in equity cases exactly what was accomplished by the defendant in the case of *Fischer v. Automobile Manufacturing Company*,²³ already commented upon. In other words, the *Bronk* case, like the *Fischer* case, gives the defendant, who is illegally and unfairly attacked for infringing a patent which common sense ought to show is not infringed, an opportunity to come directly into court, lay the alleged infringing device before the judge, and ask for a comparison and decision *instanter*. If a defendant has not a good case, or if the question of infringement is one of honest difference of opinion, then the plaintiff ought not to be deprived of the right to have a fair opportunity to lay before the court just what his invention really is and to show by experts and others, if necessary, the real meaning of the invention.

*Luten v. Camp*²⁴ is an important case in this connection since it has done most to define the meaning of rule 58. Under the prior equity rules 40, 41, 42 and 43, where it was desired to interrogate a defendant to obtain a discovery, especially upon any part of the bill, interrogatories were filed with and made part of the bill. The

²² While the claim says nothing about the "spheroidal form of the yoke portion" it refers to the "tapering plaits," etc., but the defendant's plain protector omitted the "tapering plaits" which were an essential part of the claim, so that therefore the court was correct in maintaining that there was an element of the claim omitted in the defendant's structure. Otherwise, if the court were to be taken literally as hanging its decision on the "spheroidal form" of the plaintiff's yoke, and the plain form of the defendant's, it would contravene the long established practice of our courts in support of the rule that in patents entitled at all to the doctrine of equivalents, "mere change in form, proportion or degree" does not avoid infringement, unless form was of the essence of the invention. The adoption of any such doctrine would enable a defendant to pirate a patented invention, changing its form so as not to read upon the patented claims, and then proceed forthwith to infringe, invite suit, and diagnose its own case by asking interrogatories, as done in the *Bronk* case.

Defendant's difficulty with the file wrapper might possibly have been overcome by pleading and proffering it in the answer the same as he brought his own devices in.

²³ (1912), 199 Fed. 191.

²⁴ (Mar. 17, 1915), 221 Fed. 424.

defendants in the Luten case sought to invoke the practice under the old rules to the effect that an answer to a bill, unless sworn to, was not evidence in defendant's favor, and that where an answer under oath had been waived in the bill, the answers to interrogatories in the bill need not be given under oath and therefore such answers are not evidence.²⁵ In view of this practice, defendants contended that they should be relieved from answering the interrogatories under rule 58. The defendants, however, were required to answer the interrogatories except in so far as they involved evidence and other facts not proper to be inquired into.

In *Luten v. Camp*, Judge Thompson indicates how, under new equity rule 58, substantial and radical changes have been effected in the practice as regards "discovery" and the filing of interrogatories, among which he enumerates the following: (1) The privilege of discovery has been extended to the defendant; (2) Interrogatories filed by the plaintiff are not made a part of the bill of complaint; (3) Interrogatories filed by the defendant, and defendant's answer to plaintiff's interrogatories, are not made a part of the answer to the bill; (4) Interrogatories are not pleadings; (5) Plaintiff may file interrogatories for discovery after issue.

Under the old practice, the plaintiff alone could interrogate. He, therefore, had an advantage not accorded to the defendant. The latter, if he desired a discovery, was compelled to resort to his cross bill. New equity rule 58 thus equalizes the position of the parties.²⁶

²⁵ *Tillinghast v. Chace* (1903), 121 Fed. 435; *Excelsior Wooden Pipe Co. v. City of Seattle* (1902), 117 Fed. 140; *McFarland v. Bank* (1912), 132 Fed. 399; *Calahan v. Holland-Cook Mfg. Co.* (1912), 201 Fed. 607.

²⁶ Judge Orr, in the *Pittsburg Heater* case (Apr. 15, 1915), 222 Fed. 950, 952, has observed: "The answer no longer appears to be the expression of the results of searching the conscience of the defendant. The method pointed out in rule 58 (198 Fed. XXXIV, 115 C. C. A. XXXIV) for procuring discovery by means of interrogatories is now the method of searching the conscience of the opposite party. That rule provides that the answers to the interrogatories shall be in writing under oath and signed by the party. It seems, therefore, a proper inference from the provisions of the Equity Rules with respect to oaths to portions of the record other than the answer, and the omission of the requirement of an oath to an answer, that an answer in equity need not now be made under oath."

Interrogatories and answers as evidence: The answers to interrogatories under the new practice are quite distinct, and of inherently different quality, from those evinced under the old chancery practice. Under the old practice, the party filing the petition for discovery was not bound to read the answer, but may prove his demand by any other testimony; it being within the discretion of the party calling for it whether he will use it or not; but if he offers a portion of it he makes the whole of it evidence. *Dawson Town & Gas Co. v. Woodhull* (1895), 67 Fed. 451.

The extension to a defendant of the privilege of interrogatories is not only one of the most important innovations of the new rules, but it is the one that has been most recently invoked by defendants, thus showing that this right so long withheld in American practice was something much needed, and the results of the rule in this respect are working out with marked satisfaction. It is true that under the old equity practice and the practice under bills of discovery a defendant could, by the filing of a cross bill, attach thereto interrogatories addressed to the plaintiff; but we can readily conceive of the complexity of a former patent action at law where the plaintiff had first to bring his suit at law. Then for a discovery of material evidence in the possession of the defendant, he was required to file a bill of discovery in chancery. If the defendant wanted to interrogate as to matters material to his defense and only within the knowledge of the plaintiff, he could only do so by a cross bill, or by an original bill of discovery of his own.

Under the English practice,²⁷ either party by leave of the court may submit interrogatories for answer, but interrogatories for the examination of a plaintiff are, in England, on a different footing from those for the examination of a defendant, in this respect: That a plaintiff is not entitled to discovery of the defendant's case, but a

Presumptively, answers to interrogatories are to be considered as evidence because they are not pleadings. Yet the interesting query has arisen: How far will a party be bound, who, interrogating an opponent who is naturally a hostile witness, receives answers unfavorable to his cause? Also will a sworn answer to an interrogatory come under the familiar equity provision, that to overcome it, the testimony of more than one witness to the contrary, or of one witness and corroborating circumstances, is required?

On these subjects the practice in admiralty, while having points of similarity has also points of difference from practice under the new rules. Thus in *The Serapis* (1889), 37 Fed. 436, Judge Brown said: "answers to interrogatories propounded at the close of the pleading under admiralty rules 23 and 27, are not strictly evidence in the cause, in any different sense than that in which the pleadings are evidence. *Andrews v. Wall* (1845), 3 How. 567. Though sworn to, they are not a 'deposition' for which costs can be taxed under Rev. St. Sec. 824. Such answers to interrogatories are designed rather as compulsory amplifications of the pleadings on the specific subjects propounded in the interrogatories, so as to dispense with the taking of proofs, or evidence proper, on the facts that may be admitted. When the interrogatories are propounded by the libel, the replies usually make part of the answer itself. *Dunl. Adm. Pr.* 201. It is immaterial whether they are answered as a part of a pleading or separately. As evidence, they stand like the pleadings only. They are parts of the record, and may, like the pleadings, be referred to by either party. What is admitted, needs no further proof; but as respects matters which still remain at issue, such answers are not affirmative proof in favor of the party making them. *Williams & B. Adm. Pr. (2d Ed.)* 410."

²⁷ Order XXXI, rule I.

defendant may ask any questions tending to destroy the plaintiff's case.²⁸ This distinction between the rights of the plaintiff and of the defendant to interrogate, or in the nature of the right of interrogation, does not appear to exist under our new American practice. Both seem to be on an equal footing.

MATTERS MATERIAL OR EVIDENTIARY.

Under rule 58, the inquiry must be directed only to "facts and documents material to the support or defense of the cause;" or "documents in the possession of either party and containing evidence material to the cause of action or defense of his adversary." These words have already given rise to a difference of opinion.

In the case of *P. M. Company v. Ajax Rail Anchor Company*,²⁹ the distinction between matters "material" and matters "evidentiary" was considered. There the defendant submitted nine interrogatories. The first inquired upon which of the five claims of the patent plaintiff relied. The second, third and fourth sought to have the plaintiff indicate in defendant's device certain elements described in the plaintiff's patent, and also to have the plaintiff define the phrase "other edge of the rail," occurring in the claims. The fifth interrogatory inquired whether the plaintiff had manufactured under its patent and to what extent, and requested the production of a sample, or a cut, or a drawing. The other interrogatories were directed to matters wholly irrelevant to the suit, involving the plaintiff's intention as to the possible bringing of other suits against defendant, on patents not before the court. The only interrogatory that the plaintiff was required to answer was the first one specifying which of the claims of the patent the plaintiff was going to rely upon.

²⁸ *Hoffman v. Posthill* (1869), 4 Ch. 673, 20 L. T. 893, 17 W. R. 901. In that case the defendant, in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in various patents and asked him to show in what respects they differed from his. Plaintiff declined to answer the interrogatories on the ground that the questions were not questions of fact and related to the plaintiff's case, but he was ordered to answer. In fact a defendant "has a right to ask all questions which are fairly calculated to show that the patent is not a good patent or that what he alleges to be an infringement is not an infringement."

In another case, *Ryland v. Ashleys Patent Model Co.* (1890), 7 R. P. C. 175, the defendant pleaded that the invention patented was not useful, and administered an interrogatory asking whether it had not been found necessary to use some modifications in the process described in the patent, and inquired as to what those modifications were. This interrogatory was allowed.

²⁹ (1914), 216 Fed. 634.

The more interesting of the interrogatories denied by Judge Sanborn was that relating to the demand of the plaintiff to pick out the elements in the defendant's device corresponding to the elements of the patent, and to construe or define certain phraseology used in the claim in reference to its meaning. The court quite properly held that these inquiries related to matters purely evidentiary, and to "evidence of circumstances or of facts tending to prove some contention of defendant." In referring to the English cases on the subject,³⁰ Judge Sanborn gave expression to the follow-

³⁰ *Marriott v. Chamberlain* (1886), 17 Q. B. Div. 154; *Hooton v. Dalby* [1907] 2 K. B. 18. These two English cases cited by Judge Sanborn are not equity cases, the one being an action for libel and the other for damages.

In *Marriott v. Chamberlain* (1886), 17 Q. B. Div. 154, three concurring opinions were filed, Lord Esher recognizing that defendant has a right to interrogate as to the substantial portion of material facts set up by plaintiff and the existence or non-existence of other facts relevant thereto. Justice Bowen held that even the name of a witness would have to be disclosed if it were a relevant fact in the case, independent of the position as witness.

The court said: "The right to interrogate is not confined to the facts directly in issue, but extends to any facts the existence or non-existence of which is relevant to the existence or non-existence of the facts directly in issue.

"... although one party cannot compel the other to disclose the names of his witnesses as such, yet if the name of the person is a relevant fact in the case the right that would otherwise exist to inform with regard to such fact is not disposed by the assertion that such information involves the disclosure of the name of a witness."

In *Hooton v. Dalby* [1907] 2 K. B. 18, the concurring opinion filed by Justice Buckley recognizes the ruling of Lord Esher above and the right of plaintiff to interrogate the defendant as to facts to support the plaintiff's case or impeach the defendant's, but not to support defendant's case.

Justice Buckley said: "The plaintiff is entitled to interrogate the defendant as to facts which tend to support the plaintiff's case or to impeach the defendant's case, but not as to facts which support the defendant's case."

In *Saunders v. Jones* (1877), 7 Ch. Div., 435, where the plaintiff claimed he had been wrongfully dismissed and the defendant justified the dismissal by general acts of misconduct, whereupon plaintiff filed interrogatories directed to the defendant to specify the acts of misconduct, Vice-Chancellor Bacon, in disposing of the case, said: "If the defendant will tell him what he means by the other acts of gross misconduct, what is the meaning of the charge that he has received from various persons commissions, then he knows what he is about and he comes into court at the hearing with the means of meeting the case or not, as it may be."

Further view of the English practice is seen in the following cases: *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.* (1891), 8 R. P. C. 169, where it was held that interrogatories must be limited to facts, and an interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to administer interrogatories which inquire into the opposite party's evidence; *Bidder v. Bridges* (1883), 29 Ch. Div. 29, 34, in which case it was held that

ing, which has caused considerable discussion, among members of the Bar, both as to its meaning and to its correctness:

"The nature of the case and the facts supporting it may be required to be stated. Mere evidence of facts tending to prove the nature of the case, or the facts upon which it is based, are quite generally held not proper to be inquired into."

the court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case; *Bovil v. Smith* (1854), 2 Ed. 459; *Daw v. Eley* (1865), 2 H. & M. 725, 71 Eng. Rep. R. 645.

Judge Baker, in the case of *Indianapolis Gas Company v. City of Indianapolis* (1898), 90 Fed. 196, arising under the old practice, said: "Every plaintiff is entitled to a discovery from the defendant of the matters charged in the bill, provided they are necessary to ascertain facts material to the merits of his case and to enable him to obtain a decree. The plaintiff may require this discovery either because he can not prove the facts, or in aid of proof, and to avoid expense. *Mitf. & T., Pl. & Prac.*, pp. 393, 394. It would therefore seem to be clear that the complainant, in its original bill, if it had chosen to do so, might have propounded interrogatories to the city for the purpose of obtaining the admission of such facts as would have tended to support the allegations contained in its bill."

In directing interrogatories in some of the recent cases under our new equity rules, there has been an apparent attempt to apply by analogy, the rules that pertain in common law actions for damages, libel, blacklist, boycott, etc., and to obtain, in patent cases, the benefit derived by bills of particulars in the analogous cases relied on.

Thus, in a leading case, *Patterson v. Corn Exchange of Buffalo* (1912), 197 Fed. 686, in which the bill charged unlawful combination and conspiracy of defendants to injure plaintiff's business and reputation, the court said that the defendants were "entitled to be informed in what manner they wickedly and maliciously combined and confederated together to the plaintiff's injury, and while the evidence need not be set out with minuteness as to the details of the alleged conspiracy nor its disclosure required of the names of witnesses upon whom plaintiff relies, still such particulars relating to the unlawful combination must be imparted as will enable the defendants to meet, controvert, or explain them if possible at the trial . . . applications of this character are usually granted on the ground that a bill of particulars tends to define the issue more clearly than does the complaint, and not infrequently tends to expedite the trial and to promote the ends of justice. It is thought that the defendants cannot be prepared to meet the charges contained in the complaint without being furnished with the information sought. To require the plaintiff to state the nature of the conspiracy, the acts relating to a boycott, together with the names of any defendant or defendants who refused to sell him grain or grain products, the names of those from whom he attempted to buy, and a list of his subsequent purchases from others at a loss, is not to require a disclosure of such evidence prior to the trial as is apt to result in his prejudice."

No doubt where there is any ambiguity or omission in a complaint or too wide generalization, whereby a defendant might be taken by surprise, a court would naturally give relief. For instance, it is seemingly true that if a bill of complaint alleged a conjoint use of several inventions either by plaintiff or defendant, the party who is left in doubt by the pleading might inquire as to further particulars. If a number of defendants were charged with maliciously or wilfully combining

In the later case of *Luten v. Camp*,³¹ Judge Thompson, after quoting the above paragraph from Judge Sanborn, says:

"As I construe the last sentence cited above, of Judge Sanborn's opinion, it means that it is not proper to inquire into mere evidence or facts tending to prove the nature of the case, or facts tending to prove the facts upon which it is based, not that it is not proper to inquire into the facts upon which the case is based."

Therefore, taking this construction of the rule, Judge Thompson found that it was proper for the plaintiff to interrogate the defendant as to its connection with certain blue-prints and contracts, for the purpose of showing what was defendant's connection therewith, even though it would be impracticable at that time to pass upon the relevancy or materiality of the questions relating to defendant's connection with the blue-prints and contract. The matter of infringement could only be determined at the trial. The materiality and relevancy of the contract and blue-prints depended upon the plaintiff's establishing, first, that the blue-prints infringed; and second, that they were produced by or under the direction of the defendants as part of the transactions leading up to the contract.

Also in the *Luten* case the plaintiff was denied the right to require a comparison between certain blue-prints inquired about and another set of blue-prints attached to the interrogatories, since such comparison was a matter to be established by expert testimony, or by inspection of the documents at the trial, and the opinion of the defendants would be merely evidentiary in character, and not a fact in support of the plaintiff's cause. While the interrogatories were directed apparently in search of evidence to prove infringement, the opinion indicates that possibly a similar ruling would have been made if it were attempted to prove a sale.

Another case decided by Judge Thompson simultaneously with the *Luten* case was that of *Blast Furnace Appliance Company v. Worth Brothers Company*.³² The assistance afforded the court by the learned counsel in this case and in the *Luten* case has done much to define the meaning of the purpose of discovery as practiced under the new rules. In the *Blast Furnace* case, the court

and confederating together to a plaintiff's injury no doubt the defendant would be entitled to be informed how and in what manner they had so done.

³¹ (Mar. 17, 1915), 221 Fed. 424, 428.

³² (Mar. 17, 1915), 221 Fed. 430.

in brief decided: (1) That matters disclosed in the answer material to the plaintiff's case may be made the subject of interrogatories; (2) That the defendant, having attached to its answer a copy of a contract for furnishing drawings in which there was an agreement to issue a license, the plaintiff was entitled to know whether the license was in writing, or oral, and whether the license was for the use of the patent sued on; (3) That as the defendant in its answer claimed a set-off, plaintiff was entitled to interrogate as to the dates and amounts of payments constituting the set-off; (4) That the plaintiff was entitled to have the defendant furnish, for plaintiff's inspection, drawings of certain constructions in question, as being material to the charge of infringement; (5) That the defendant answer when it began the construction of a certain device, as material to the fixing of the time of the alleged infringement; and (6) That the defendant answer whether a certain license was in writing or not, in order that the plaintiff might call for its production.

INSPECTION.

The Luten case is further interesting in holding that while a plaintiff was not entitled by interrogatories to copies of, or inquiries concerning the contents of certain blue-prints, nevertheless, he was entitled, on a proper showing, to have an order made for their production and inspection, the blue-prints being the best evidence of their contents. The case of *Todd v. Whitaker*,³³ arising before Judge Dickinson in Pennsylvania, and cited by Judge Thompson in the Luten case, held to the same effect, that is, that while a party was entitled to inspect a document or thing on the propounding of interrogatories, he was not entitled to copies of the same before trial.

In the *Todd* case, the plaintiff sought by a motion for particulars to require the defendant to disclose the particulars of the prior user relied upon. In this attempt the plaintiff evidently relied on the common law rule that when a pleading sets forth facts constituting the essential elements of a cause of action, while not demurrable, if it is so general as to afford opportunity for surprise when the proof is taken, a bill of particulars may be resorted to in order to secure the requisite certainty.³⁴ It would seem apparent

³³ (1914), 217 Fed. 319.

³⁴ *Singers-Bigger v. Young* (1908), 166 Fed. 82; *Rinker v. United States* (1907), 151 Fed. 755; *Patterson v. Corn Exchange of Buffalo* (1912), 197 Fed. 686.

that the plaintiff there mistook his remedy. The defendants had set up prior user under section 4920 of the Revised Statutes, and the effect of plaintiff's motion was not only to require of defendant more than the statute demanded of him, but was apparently an inquiry into the nature of defendant's evidence.

In *Woodbury Patent Planing Machine Company v. Keith*,³⁵ the Supreme Court had held, in construing section 4920 of the Revised Statutes, that the

"true construction of the Act of Congress is that only the names of those who had invented or used the anticipating machine or improvement, and not the names of those who are to testify of its invention or use, are required to be pleaded. It was so ruled by Mr. Justice Grier, in *Wilton v. The Railroads* (1 Wall, Jr. 195), and by Mr. Justice Nelson, in *Many v. Jagger*, 1 Blatchf, 376. *Roemer v. Simon*, 95 U. S. 214. This is all that is necessary to protect a patentee against surprise. If, in regard to an invention claimed to have anticipated his own, he is informed by the defendant's answer of the names and residences of the alleged inventors, or who had prior knowledge of the thing patented, and when and by whom it had been used, it is sufficient to apprise him of the defense, and to enable him to make all needful inquiries respecting it. He need not know who are to testify in regard

In *Todd v. Whitaker* (1914), 217 Fed. 319, the court overruled the obviously improper interrogatory of the defendant as to when the plaintiff conceived the invention of the patent in suit. That was purely evidentiary matter, and in no sense essential to defendant's defense.

In the *Todd* case plaintiff argued that since the new equity rules are largely based upon the English chancery rules, and since in England the practice requires what plaintiff is now seeking, the English rule should prevail, plaintiff reading from an address by A. J. Walters, K. C. (1913), 38 Am. Bar Assn. Rep. 789.

In reply it was pointed out that in England there is a special set of rules applicable to patent cases exclusively, and one of these special rules provides specifically for the furnishing of drawings or similar description of alleged prior devices to be relied upon; that we have no such special rule here and as our equity rules are largely based on English rules, the failure to include a special rule of this kind argued against plaintiff rather than for him; and that the very existence of the special rule was a strong indication that the general chancery rules were not regarded as forming a foundation for the practice, else the special rule would have been unnecessary.

For the defendant it was further pointed out that the purpose of the bill of particulars is not to disclose the specific evidence nor to furnish facts which are equally accessible to both parties, 3 Ency. Pl. Pr. 520, 529; and that neither should the bill of particulars be made an instrument of injustice by increasing the burden of expense already upon a defendant in patent cases, by requiring him to have expensive drawings made or photographs taken, in the absence of a proper verified showing.

³⁵ (1879), 101 U. S. 479, 25 L. Ed. 944.

to the invention or use; much less does he need to know who are to testify respecting the history and use of the prior invention, after the complainant's patent has been granted."

Evidently adopting this rule in the Todd case, Judge Dickinson said:

"Where the answer sets up the existence of *some concrete thing* which may be made the subject of an exhibit as a publication, drawing, photograph, or device which is claimed to be an anticipation of the patented device, and which is proposed to be made the subject of expert testimony, the plaintiff may fairly ask to have it submitted in advance to the inspection of expert witnesses for the plaintiff. If a request for opportunity to make this inspection be denied, or if what is offered in evidence differs from what was submitted for inspection, the present rules furnish the means of preventing a plaintiff from being taken by surprise."

This case, and the Luten case, unquestionably establish the right of a party to inspection before trial and the proper way to secure such inspection is by interrogatories under the new rules.³⁶

The right of inspection, of course, is not a new idea, having been recognized both under our own former equity practice and under the English chancery practice.³⁷ Under the old rules in this

³⁶ Inspection in England is allowed under section 34 of the Act of 1907: "In an action for infringement of a patent, the court may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the court may see fit."

In England interrogatories as to prior use are permitted so far as they do not relate to evidentiary matters. In a case where a plaintiff asked whether the alleged prior use was in respect to a particular process specified, the defendant's answer that the prior use was substantially the process described in plaintiff's patent was held sufficient. *Delta Metal Co. v. Maxim Nordenfelt* (1891), 8 R. P. C. 169.

In another case, *Carnegie Steel Co. v. Bell Bros.* (1907), 24 R. P. C. 82, the court said: "Particulars of prior user must be given; evidence of prior user need not be given."

³⁷ In *Colgate v. Compagnie Francaise du Telegraphe de Paris*, etc. (1885), 23 Fed. 82, Judge Wallace pointed out that courts of equity in patent causes had sometimes exercised the power of granting to a complainant an inspection of the alleged infringing devices as incidental to ordinary discovery, citing *Vidi v. Smith* (1854), 3 El. & Bl. 969; *Morgan v. Seward*, 1 Web. Pat. Cas. 169; *Russell v. Cowley*, Id. 468; *Shaw v. Bank of England* (1857), 22 L. J. Exch. 26. "Courts of law have no such authority, but power to do so was conferred in England upon common law courts by 15 and 16 Vict. c. 83, Sec. 43. Manifestly, cases may occur where the exercise of this power is necessary in order to prevent a defendant from profiting by his own artifice. The case made by the present bill is one where, if the defendant has appropriated the complainant's invention, it would be obviously difficult if not impossible, to prove the fact unless an inspection were granted."

country, inspection was frequently had by motion of plaintiff, but only under certain well defined conditions, although the authorities were not always in accord as to the application of the rule. A leading case is *Rowell v. William Koehl Company*.³⁸ This was a motion by plaintiff for an order directing the president of the defendant corporation to produce a copy of his pending application for a patent, and for an inspection of defendant's machine for making pill boxes. Complainant's affidavits showed that the defendant used in its factory a machine for making the various parts or body portions of the box, and then automatically assembled them to make a completed box; that the boxes of the defendant had three parts, the cardboard cylinder, the cardboard disk, and the gummed paper, and that when such parts were united by the machine they were similar in appearance, size, and form to the boxes made by the patented machine of the complainant. From the appearance of the defendant's product, and from the testimony of its president, complainant's expert witness testified that he formed the opinion that in its principal operating parts the machine of the defendant was similar to that described in the patent in suit, and that the defendant employed either the identical mechanism or mechanical equivalents to achieve the result. It further appeared that the defendant, in the year 1907, built and used a machine concededly not unlike the complainant's, and upon receiving notice of infringement had abandoned its use. Defendant's machine was secretly operated, and defendant declined to produce the same for inspection, on the ground that an application for a patent covering it in all its details had been filed in the Patent Office.

While it was conceded that the court had power to compel the disclosure of the application for a patent, or the inspection of the machine, it was contended that no *prima facie* showing of infringement had been made, and that the defendant's machine embodied trade secrets. The court held that the concealment by the defendant of the machine and the method of making its boxes, its declination to furnish a description of the essential parts, and the similarity of the boxes, that is, the product of the machine, were "sufficient grounds for suspicion" of infringement; that while the burden is on the plaintiff to prove infringement, yet where a defendant declines to show the machine, "there is a presumption of identity"

³⁸ (1912), 194 Fed. 446.

between the machines,³⁹ and that where the additional evidence produced shows inferentially that the patented article was made by machinery such as described in the patent, there is reasonable cause for believing infringement exists. Of course, in all cases the application for inspection must be made in good faith. The court, therefore, ordered that defendant either furnish a copy of the application, or permit an inspection of the application in the Patent Office,⁴⁰ according to defendant's preference, or that a master be appointed to inspect defendant's machine at its factory and furnish a report to the court. This order, it is to be noted, did not say that this should be done *in camera*.

In the later reported case of Eibel Process Company v. Remington-Martin Company,⁴¹ Judge Ray expressly disapproved of Judge Hazel's opinion in the Rowell case, and held that "suspicion" of in-

³⁹ 3 Robinson, Patents, 305.

⁴⁰ A pending application of a defendant is not privileged. Edison El. Light Co. v. United States El. Light Co. (1890), 44 Fed. 294. In this case, plaintiff had a pending divisional application. An ambiguity appeared in the patent sued on capable of two meanings and defendant claimed that the divisional application explained these matters and greatly restricted the claims of the patent in suit. It was ordered that the subpoena duces tecum be obeyed.

English practice: Communications between an applicant and his patent agent are not privileged. Moseley v. Victoria Rubber Co. (1886), 3 R. P. C. 351.

An English case similar in its facts to Rowell Co. v. William Koehl Co. is that of Bovill v. Moore (1815), 2 Coop. 46, (reported in Dav. Pat. Cas. 361, 402), involving a machine for making bobbin lace. There Lord Eldon said: "Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

Other instances of inspection under the English practice will be shown in the following cases: Smith v. Edlin-Sinclair Type Co. (1903), 20 R. P. C. 435; Russell v. Crichton, 1 Web. Pat. Cas. 667; Batley v. Kynoch (1875), 44 L. J. Ch. 565; Flower v. Lloyd (1876), W. N. 169, 230.

A now famous order of inspection is that relating to the Keely motor, in the case of Wilson v. Keely, 43 O. G. 511.

The true theory of inspection appears to be well set out in the case of Dobson v. Graham (1889), 49 Fed. 17, where the court said: "If it were shown that these secrets are used as a cloak to cover an invasion of the plaintiff's rights or if there was reliable evidence tending to show it to justify the belief that they are sound, the motions would be sustained."

⁴¹ (1912), 197 Fed. 760.

fringement is not enough to justify such an order. Judge Ray pointed out that a motion was premature until a *prima facie* case has been made out by taking testimony, and concealment by defendant of its alleged infringing devices or of plans, drawings or documents has been shown.⁴²

Judge Ray correctly points out that it is a serious thing to direct a manufacturing corporation to allow the attorney and patentees and experts of a rival concern to enter its plant and inspect and measure its machinery, and the operation thereof, and compel it to furnish samples of its stock and product. But he failed to point out that, from a plaintiff's point of view, inspection is often essential under modern manufacturing conditions, where it is almost impossible for a patentee to obtain access to a rival's factory and to prove, with any degree of exactness, what type of machinery or processes are being employed, although the patentee may have ample legitimate reasons for believing that his patented device or process is being wrongfully employed.⁴³ Just how far, under the new rules, courts will require the answering of interrogatories, inquiring into the doings of a defendant, remains yet to be determined.

In a case in the Ninth Circuit,⁴⁴ Judge Van Fleet, in an unreported memorandum opinion, sustained defendant's objections to interrogatories directed by plaintiff asking defendant whether or not it had made or sold any pumps corresponding to a blue-print attached to the interrogatories. Defendant's objections were made particularly on the grounds given in Judge Ray's opinion; also upon the grounds that there was no showing of any lack of knowledge on the part of plaintiff of the facts sought to be discovered or any

⁴² In this connection the court cited *Dobson v. Graham* (1889), 49 Fed. 17; *Diamond Match Co. v. Oshkosh Match Works* (1894), 63 Fed. 984.

⁴³ In England generally the plea of a defendant that his process is secret does not avail him against answering interrogatories. *Rennard v. Levenstein* (1864), 3 N. R. 665; *Ashworth v. Roberts* (1890), 7 R. P. C. 455.

In order, however, to obtain an inspection of a supposed infringing machine, not only must a *prima facie* case be made out, but where the thing or process inspected is secret, the inspection will be granted to scientific witnesses who will be required to keep any secrets which they may have discovered and do not affect the question of infringement, the court frequently limiting the inspection to scientific men and excluding the plaintiff from being present. *Flower v. Lloyd* (1876), W. N. 169, 230; *Swan v. Edlin-Sinclair Type Co.* (1903), 20 R. P. C. 435.

⁴⁴ *International Steam Pump Co. v. Dow Pump & Diesel Engine Co.* unreported.

concealment of any acts, or any secret action by the defendant; that the bill was verified and alleged categorically, and not on information and belief, the facts on which plaintiff sought relief, including the question of infringement; and that the proceedings were in the nature of a "fishing expedition" to bolster up a suspected cause of action.⁴⁵

This right of inspection, however, does not prevent the protection of an honest trade secret, although with the privileges of the patent and copyright laws, there can be few bona fide cases of trade secrets, and courts should view them with disfavor, if not suspicion.⁴⁶ In my opinion, a rule similar to that applied by Judge Van Fleet will prevail in American practice.

⁴⁵ Fishing excursions: We have seen how Judge Lurton, in the case of *Carpenter v. Winn* (1911), 221 U. S. 533, 55 L. Ed. 842, drew attention to the fact that "fishing bills" or bills in the nature of fishing excursions had always been abhorrent to equity. This is also the rule today in England, as seen by the answer of the Lord Chancellor to Mr. Justice Lurton's question relating to equity procedure in England: "A fishing discovery, that is to say, discovery in order to enable the applicant to fish for a cause of action when he has no materials of his own, is disallowed. It must always be a matter of decision upon the circumstances in each case whether it is a fishing application or not."

⁴⁶ As Mr. Wigmore in his work on Evidence points out:

"In an epoch when patent rights and copyrights for invention are so easily obtained and so amply secured, there can be only an occasional need for the preservation of an honest trade secret without resort to public registration for its protection. Such instances do occur, but an object of the patent and copyright laws is to render them as rare as possible, and the presumption should be against their propriety. In other words, a person claiming that he needs to keep these things secret at all should be expected to make the exigency particularly plain. In the next place, the occasion for demanding such a privilege arises usually in actions where the party claiming it is as one charged with infringing the rights of another by fraudulent competition in business, and the existence of the fraud can be proved only by investigating the claimant's methods of business. In such cases it might amount practically to a legal sanction of the fraud if the court conceded to the alleged wrongdoer the privilege of keeping his doings secret from judicial investigation. No privilege at all should there be conceded, although as much privacy as possible might be presented by compelling disclosure no farther than to the judge himself, or to his delegated master, or auditor, if (as is usual) the cause is tried by Chancery procedure. . . . In other words, the privilege should be conceded in those cases only where the disclosure of the facts by the particular channel of the witness in question is but a subordinate means of proof, relative to the other evidence available in the case; for without some such limitation the general principle cannot be enforced that testimonial duty to the community is paramount to private interests, and that no man is to be denied the enforcement of his rights merely because another possesses the facts without which the right cannot be ascertained and enforced." Wigmore, *Evidence* (1894), vol. 3, § 2212, pp. 3001-3002.

The case of *E. I. DuPont de Nemours Powder Co. v. Masland* (Apr. 12, 1915), 222 Fed. 340, presents an interesting and unusual case of discovery and trade secrets.

DISCOVERY BY DEMAND UNDER PARAGRAPH 6, RULE 58.

The last paragraph of new equity rule 58 provides that either party may serve a demand ten days before trial calling upon the other to admit in writing the execution or genuineness of any document, letter or other writing; and if such admission be not made within five days, the costs of proving the document, letter or writing may be imposed upon the delinquent.

This paragraph has no precedent under the old rules. It no doubt will be extensively used to prove assignments, licenses, agreements, contracts showing possible infringement or intention to infringe, plain uncertified copies of United States and foreign patents, printed publications by way of anticipation, and original drawings of the alleged infringing machine emanating from or connected with the defendant, though it is doubtful if a drawing prepared expressly for the purpose of suit could be proved under the rule, for the purpose of establishing infringement.

PROCEEDINGS UNDER RULE 48.

In the matter of inquiry into prior use, Judge Dickinson, in *Todd v. Whitaker*, made one pertinent observation which may save the Bench and Bar much worry about resorting to interrogatories: That proceedings under rule 48 for the taking of depositions of experts would furnish all the information which could fairly be asked concerning an inspection of a prior use, and there would seldom be occasion to resort to interrogatories in such matter. This is quite true if we but realized that under rule 48 the plaintiff is merely required to make out his *prima facie* case as to infringement, assuming, of course, that the acts of infringement are within

There the bill was filed to restrain defendants from disclosing trade secrets to plaintiff obtained by defendants as employees and confidentially communicated to them.

Defendant was given information as to what the alleged secret processes were, the formula of which was kept in camera. The defendant stated that the so-called secrets of plaintiff were not secrets but old processes and which anyone had a right to use. Defendant then gave notice of an intention to employ experts to discuss with them the matter. This alarmed plaintiff who applied for a restraining order which was granted. Then witnesses for the plaintiff were asked on cross-examination to state the formulae embodying the secret processes, and the present motion to vacate was brought. The judge said: "This difficulty could be met by an appropriate order for keeping the answers to the questions asked in camera." The defendant was denied the right to disclose any information to their experts.

The ultimate disposition of this case will be awaited with interest.

the knowledge of the plaintiff. The latter is not concerned for the time being with the defendant's prior user; the plaintiff only needs to know the extent and character of the prior use in time to prepare intelligently for trial. But, presumably, the defendant's expert will of necessity fully outline in his affidavit the nature and character of the prior use. Hence, the plaintiff then has an opportunity before trial to make full answer thereto, so that the danger of surprise that might otherwise be possible if the nature of the prior use were left until the time of the trial, may be wholly avoided by timely action taken by plaintiff to apply to have the case placed subject to rule 48.

While rule 48 is in no correct sense a discovery in the usual meaning of the word, yet by proceeding under it the need for discovery, as far as prior user is concerned, is in a large measure obviated. In other words, it is an insurance to the plaintiff against surprise at the trial, and in that respect it is an effective discovery to him.

EQUITY RULES 25 AND 30.

Likewise, the rulings of certain of the courts under rules 25 and 30, concerning the form and substance of bills and answers, are in the line of discovery for one or the other of the parties. Here we see a further radical departure from the old practice and one whose possibilities have not yet fully been exploited or defined.

The only reported case in which this matter has been considered, bearing on the subject of discovery or further particulars against surprise, is that of *Coulston v. H. Franke Steel Range Company*.⁴⁷ This was on a motion of plaintiff that the defendant be required to make its answer more definite and certain by setting forth in what respects each of the patents, pleaded in the answer as anticipations, disclosed any of the elements or combinations of elements described in plaintiff's letters patent, and in what respect they negatived the novelty and invention of the device of the patent.

The court points out that the apparent purpose of the rule is to establish in equity cases in the federal courts some of the short cuts provided by the state codes. It further illustrates the abuse, detail, expense and burden to courts and litigants of the old practice of setting out numerous patents in an answer and then only

⁴⁷ (Mar. 8, 1915), 221 Fed. 669.

relying on a limited number, if any, of them. Such practice leaves the court, when hearing the testimony, wholly in the dark as to what may be relevant and what irrelevant. Judge Clarke says:

"I am convinced that it was the purpose of the new rules to require that counsel shall so study the patents on which they intend to rely that in their pleadings they can state in short and simple terms what they claim with respect to them, rather than to defer such study until after a record is made up of volumes of irrelevant matter, and then, by study and analysis, to pick out what is essential to a decision of the case. . . .

"This court cannot refrain from observing in this connection that the old notion that a suit at law or in equity is chiefly a game affording an opportunity for the matching of wits of counsel and for the exercise of the ingenuity of courts is fast giving place to the conception that suits both at law and in equity should be sincere and candid attempts to reach the real point of difference between the parties to them, and to secure a just settlement of such difference."

With these thoughts in mind, it is not at all surprising that the court allowed the motion of plaintiff. Thereupon, the defendant, acting on the suggestion of the judge, made a motion that the plaintiff, in turn in his complaint, set out in plain terms what new and inventive contribution to the old art was made by the patentee and disclosed in the patent and claimed to be infringed by the defendant; in other words, to require the plaintiff to point out what was the real invention of the patent and claims sued on. The defendant's motion was granted, and the court for the Northern District of Ohio drafted the following rule governing patent pleadings in that jurisdiction:

"Counsel are advised that hereafter in pleading in patent cases the provisions of new Equity Rules No. 25 and 30 must be strictly complied with, requiring 'a short and simple statement of the ultimate facts upon which the plaintiff asks relief' and a statement in short and simple terms of the defense to each claim asserted in the bill.

"A general reference to a patent will not be accepted as a sufficiently definite compliance with these rules."

While the theory of requiring the plaintiff in his complaint to definitely define his invention is good, it is unquestionably an assumption by plaintiff of the prerogative of the court to attempt to construe his patent, the patent being the best evidence of its legal effect, and this legal effect varying with the quality of the prior art developed by the defendant, aside from any showing of the file

wrapper of the patent. If the rule required the pleading of a patent, and also required a reference to the file wrapper as construing it, so as to make the file contents a part of the bill, an immense step forward would be taken towards informing the court *ab initio* of the scope and character of the patent. Of course, few plaintiffs desire to do that unless the file wrapper was very much in their favor, but that would be the very reason for plaintiff's bringing the file wrapper before the court, both for the purpose of informing the court and the defendant.

The order entered in the Coulston case, as far as it relates to the plaintiff, is largely, if not wholly, an empty one, for a plaintiff will naturally shape the definition of his invention to suit his own ends. Even if he may have reason to suspect that the defendant will rely on certain evidence to limit his patent, it is not seen how he can be required to anticipate such a defense. In addition to that, it is abhorrent to the rule that a plaintiff cannot be compelled to forecast with absolute certainty the theory of either the law or the facts which he will finally be compelled to unfold at the trial.⁴⁸

In conclusion, I cannot better express the purpose and intent of the new rules, and the duty entailed upon all of us as members of the Bar, than to quote the concluding words of Judge Clarke in the Coulston case: "The application of the new equity rules to patent cases should command the cordial support and assistance of the Bar, without which, of course, judges will be in large part powerless to give them full effect. It may be that there is much in the claim often made that the new equity rules cannot be successfully applied to pleading in patent cases, but several judges throughout the country, notably in the Southern District of New York and in Massachusetts, are making a determined effort to give the application of them to such cases a fair trial. With this effort this court is in entire sympathy, both from its conviction that it is its duty to

⁴⁸ To quote from the recent case of *Gimbel Bros. v. Adams Express Co.* (1914), 217 Fed. 318: "We cannot subscribe to the proposition that a plaintiff can be compelled to attempt to forecast, with absolute accuracy, the theory of either the law or the facts which he will be finally compelled to unfold at the trial. If he was so compelled and did not accurately forecast the theories, both of law and of fact, which he finally at the trial determines to be the true ones, he would be driven to an amendment of his pleadings. It is permissible for him to so state the facts as to leave him free to evolve any theory at the trial which is supported by them. The practical conditions of the trial compel him eventually to make an election among the possible theories on which the case may be tried, but he is under no compulsion to make his election in advance of the trial."

give effect to these rules, prescribed by the Supreme Court of the United States, and also because of its conviction that their application to such cases will greatly curtail the extent of records made up in them, and so the expense to litigants, and will result in a genuine reform, leading to a more prompt decision of cases, and also to a large measure of justice in the determination of them. Delay of decision and excessive cost often defeat justice."

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